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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,625	01/16/2002	Paul Dvorkis	04873-074002	7569

26161 7590 07/17/2003

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

FRECH, KARL D

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/050,625

Applicant(s)

DVORKIS ET AL.

Examiner

Karl D Frech

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The preliminary amendment canceling claims 1-12 has been entered as paper number 2.
2. The disclosure is objected to because of the following informalities: applicant is requested to fill in the blank spaces on page 3 of the specification regarding the copending applications.

Appropriate correction is required.

3. Claims 13-20 are objected to because of the following informalities: applicant claims that there is "beam shaping optics" in the beam. However, the optics can not physically be in the beam itself, as the beam is light, but in the beam path. It is suggested that applicant substitute "beam" with –beam path— where appropriate. Appropriate correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

Claims 13,14,15,16,17 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Applicant admits in the current specification that subject matter which is shown in figures 1,6 and 7. Figure 1 shows an optical indicia scanner with a laser light source 12 which creates a light beam with a non-circularly-symmetric cross section with an x-axis component of the light beam and a y-

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axis component of the light beam being differently divergent (fig 7). Figure 1 also shows a negative beam-shaping optical element in the part cylindrical concave mirror 32, which as shown in the figure has an axis parallel to the x-axis of the light beam.

Applicant admits on page 14 line 7 that gain guided lasers are prior art.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 18, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art. Applicant admits to that which is shown above.

Applicant does not admit to the index guided laser. However, index guided lasers are old and well known. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use an index guided laser instead of the gain guided laser. Since both were known, and since there is no criticality disclosed within the

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specification, these two would be operational equivalents. Applicant admits as seen in figure 7 that it is known that the x-axis beam waste and the y-axis beam waste are at different distances from the source. Applicant does not admit that the x-axis beam waste is further from the source than the y-axis beam waste. This, however, is merely reorienting the axis of the optical elements within between the light source and the detector. It would have been obvious to a person of ordinary skill in the art at the time of the invention to reorient the optical elements in order to achieve the most efficient operation.

4. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or fairly suggest to one of ordinary skill, in conjunction with all the limitations of independent claim 13, and intermediate claim 19, that the negative beam-shaping optics adjusts the spacing between the x-axis waste and y-axis waste without changing the overall magnification.

6. The examiner notes that the entire rejection is based upon admitted prior art. Although the invention which is disclosed may be novel and unobvious, the current claims are written in a manner which the examiner must broadly interpret the claimed elements.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dvorkis et al 5,742,038 and 6,220,514 claim similar embodiments but do not claim the negative optics as currently claimed. Bard et al

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5,170,277, Dvorkis et al 5,235,167, Swartz et al 6,000,617 and 5,734,153, Barkan et al 6,454,167 and Shepard et al 5,017,765 all disclose two dimensional optical scanners with x and y components which can be independently adjusted.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D Frech whose telephone number is (703) 305 3491. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 308 4075. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308 7722 for regular communications and (703) 308 7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0956.



Karl D Frech
Primary Examiner
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July 12, 2003